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PATENT APPLICATION

ATTORNEY DOCKET NO. 10007788-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): John David Laughlin

Confirmation No.: 1847

Application No.: 09/976,302

Examiner: DEBROW, James J.

Filing Date: October 11, 2001

Group Art Unit: 2176

Title: Method and System for Defining Separate Print Quality Regions within a Print Job

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on September 23, 2008 .

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

Respectfully submitted,
John David Laughlin

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REPLY BRIEF

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Sir:

This is a Reply Brief under Rule 41.41 (37 C.F.R) in response to the Supplemental Examiner's Answer of October 20, 2008 (the "Examiner's Answer" or the "Answer"). In Section 10, the Answer contains a response to some of the arguments made in Appellant's brief. Appellant now responds to the Examiner's Answer as follows.

VII. Argument

(1) Claims 2-5, 11, 12, 18, 19, 25-27 and 29-33 are patentable over Naik and Terasaka:

Claims 2, 11, 18, 25, 32 and 33

For reference and by way of example of the claims in this group, claim 2 recites:

A printer driver stored on a computer-readable medium comprising:
an interface configured to receive print job data;
a print job formatting routine which notes one or more regions within a print job derived from said print job data and further specifies a particular print quality level at which each such region is then printed;
a WYSIWYG display routine for generating a WYSIWYG display of said print job; and
a user input routine for receiving user input defining said one or more regions within said print job using said WYSIWYG display, *wherein said user input can selectively define any portion of said print job as a said region with an independently-specified print quality level, said regions including or excluding any particular element or elements of said print job as desired by a user.*

(Emphasis added).

In contrast, the cited prior art references, taken in any combination, do not teach or suggest a print driver, system or method in which a user can specify different print quality levels for different *user-defined regions* of a print job. It is significant that Appellant's claims recite "wherein said user input can selectively define any portion of said print job as a said region with an independently- specified print quality level, said regions including or excluding any particular element or elements of said print job as desired by a user."

The Office Action of March 20, 2008 expressly conceded that "Naik [of record] does not expressly disclose ... a user input routine for receiving user input defining the one or more regions within the print job using the WYSIWYG display, wherein the user input can selectively define any portion of said print job as a said region with an independent-specified print quality level, said regions including or excluding any particular element or elements of

said print job as desired by the user.” (Action of March, p. 4). Consequently, the Answer relies on Terasaka (of record).

Recognizing the fact that the Examiner has taken different and contradictory views of what Terasaka teaches during the prosecution of this application, the Answer now argues the following:

Terasaka teaches [that] the operator can perform an operation to modify the print setting of the print driver and/or the print setting of the host terminal printer emulator TMI contained in the WYSIWIG system. The process then uses the modified setting to create a modified preview. Terasaka also teaches the print request processing and print setting storing section in the WYSIWYG system has a terminal configured table and one print setting table for each terminal which contains the optimum print setting for each kind of form.

(Examiner’s Answer, p. 24).

The Answer overlooks, however, that Appellant has established on the record, with evidence from Terasaka itself, that Terasaka only suggests adjusting setting such as print quality level on a page-by-page basis. Consequently, Terasaka cannot teach or suggest the subject matter for which it is cited, namely, the claimed feature “wherein said user input can selectively define any portion of said print job as a said region with an independently-specified print quality level, said regions including or excluding any particular element or elements of said print job as desired by a user.”

The Answer makes much of the fact that Terasaka teaches “partial printing as an advantage of the system. Thus[, according to the Answer,] one of ordinary skill in the art would conclude that the print setting, which can be modified, as applied to the whole document, could also be applied to the document or regions of the document as it applies to partial printing.” (Examiner’s Answer, pp. 24-25). However, as Appellant must apparently explain again, Terasaka’s reference to “partial printing” does not teach or suggest that the “user input can selectively define any portion of said print job as a said region with an

independently- specified print quality level, said regions including or excluding any particular element or elements of said print job as desired by a user,” as claimed.

The only mention in Terasaka of “partial printing” reads as follows.

As is apparent from the above description, the present invention offers significant advantages as described below.

- (a) Paper wastage is reduced because of reduced possibility of print errors.
- (b) No strain is imposed on communication traffic since the processing serves to reduce the number of times the printer driver is loaded.
- (c) Paper size can be changed for each form even when printing continuous-form paper using a standard printer driver.
- (d) *Partial printing is easy because the printed page count matches between the host computer and the host terminal printer emulator.*

(Terasaka, col. 8, lines 18-32) (emphasis added).

Thus, it would appear that Terasaka mentions partial printing *only on a page-by-page basis*, i.e., “[p]artial printing is easy because *the printed page count matches* between the host computer and the host terminal printer emulator.” (*Id.* at col. 8, lines 29-31) (emphasis added). Clearly, there is no teaching or support here or elsewhere in Terasaka for the claimed subject matter of “receiving user input defining one or more of said regions within said print job using said display, wherein said user input can selectively define *any* portion of said print job as a said region with an independently-specified print quality level, said regions including or excluding any particular element or elements of said print job as desired by a user.” (Emphasis added).

Although Appellant made this argument previously, there is no substantive response in the Answer to Appellant’s demonstration that Terasaka teaches partial printing only *on a page-by-page basis*, which does not anticipate or render obvious the subject matter of Appellant’s claims.

For at least these reasons, and Appellant's previous explanations on the record, the Board should not sustain the rejection of claims 2, 11, 18, 25, 32 and 33, and their respective dependent claims, based on Naik and Terasaka.

Claims 3 and 19:

The rejection of claims 3 and 19 should not be sustained for at least the same reasons given above in favor of the corresponding independent claims. For reference, claim 3 recites "wherein said user input routine is configured to receive user input specifying a particular print quality level for each of said one or more regions defined within said print job." Claim 19 similarly recites "wherein said user input routine is configured to receive user input specifying a particular print quality level for each of said one or more regions defined within said print job."

The Answer fails to provide any further explanation as to how the subject matter of these claims is rendered obvious by the cited prior art. As Appellant has demonstrated records, the claimed subject matter is absent from the cited prior art. For at least these reasons, the rejection of claims 3 and 19 should not be sustained.

The Answer mentions in passing that "Claims 3 and 19 appear as being of improper dependent form for failing to further limit the subject matter of their respective previous corresponding claims." (Examiner's Answer, p. 26). It is unclear whether the Examiner intended this statement to constitute a new ground of rejection. If so, it is improper.

Any new ground of rejection made by an examiner in an answer must be: (A) approved by a Technology Center (TC) Director or designee; and (B) ***prominently identified in the "Grounds of Rejection to be Reviewed on***

Appeal" section and the "Grounds of Rejection" section of the answer (see MPEP § 1207.02).
(MPEP § 1207.03, section I) (emphasis added).

The Answer does not appear to have had any new ground of rejection “approved by a Technology Center (TC) Director or designee.” (*Id.*). Moreover, the Answer does not prominently identify any new grounds of rejection in the “Grounds of Rejection to be Reviewed on Appeal” section and the “Grounds of Rejection” section of the Examiner’s Answer. (Examiner’s Answer, pp. 3 and 25-26). For at least these reasons, any rejection of claims 3 and 19 as of improper dependent form is improper on this record and cannot be sustained.

In any event, claims 3 and 19 do further limit their respective base claims as required by 37 C.F.R. § 1.37 CFR 1.75(c). The respective independent claims 2 and 18 recite a user input routine through which a user selectively defines any portion of a print job. Both claims 3 and 19 further limit the subject matter of their respective independent claims by reciting that the user input routine is configured to *receive user input specifying a particular print quality level for each of the one or more regions* defined within a print job. (emphasis added). Therefore, claims 3 and 19 further limit claims 2 and 18, respectively, and any corresponding rejection of claims 3 and 19, if properly made, should not be sustained.

Claims 5 and 12 are patentable over Naik and Terasaka:

Claim 5 recites:

The printer driver of claim 4, wherein said user input routine is configured to display movement of a cursor on said WYSIWYG display in response to physical movement of said mouse, said *movement of said cursor being used by said user input routine to define said one or more regions within said print job.* (emphasis added).

Claim 12 similarly recites: “The method of claim 11, further comprising specifying said one or more regions within said print job by moving a cursor driven by a mouse over said WYSIWYG display.”

As demonstrated above, the teachings of the cited prior art do not include user-defined regions as recited in the Appellant’s independent claims. Consequently, the cited prior art cannot teach or suggest, as recited in claims 5 and 12, that such regions are defined by “movement of a cursor on said WYSIWYG display in response to physical movement of said mouse.” (Claim 5).

In rejecting claims 5 and 12, the Answer relies entirely on the incorrect position that the cited prior art renders obvious Appellant’s independent claims and, that being the case, claims 5 and 12 are obvious as well. (Answer, p. 26). Thus, the Answer provides no substantive response to the arguments in favor of claims 5 and 12, merely the conclusion that the claims are obvious.

In a recent decision, the Board of Patent Appeals and Interferences stated the following:

The Examiner’s articulated reasoning . . . in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The Supreme Court, reiterating this reasoning by citing *In re Kahn*, 441 F.3d at 988, stating that ‘rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ *KSR* at 1741.

Ex Parte Val Mandrusou, Application Serial No. 10/235,221, 2008 WL 2845083 (B.P.A.I. 2008).

Therefore, the Answer has clearly failed to make out a *prima facie* case of obviousness against claims 5 and 12. Therefore, the rejection of claims 5 and 12 should not be sustained.

(2) Claims 22-24 and 28 are patentable over Naik, Tersaka and Nicoloff:

This rejection should not be sustained for at least the same reasons given above in favor of the patentability of the corresponding independent claims.

In view of the foregoing, it is submitted that the final rejection of the pending claims is improper and should not be sustained. Therefore, a reversal of the Rejection of March 20, 2008 is respectfully requested.

Respectfully submitted,

DATE: November 19, 2008

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